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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,656	01/30/2002	Yoshihisa Tsukada	0649-0821P-SP	3874

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EXAMINER	
CHEA, THORL	

ART UNIT	PAPER NUMBER
1752	

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/058,656	TSUKADA ET AL.	
	Examiner	Art Unit	
	Thorl Chea	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 April 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3 and 5-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3 and 5-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-3, 5-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims are indefinite for failing to provide a processing steps for preparing the heat-developable material. The "emulsion polymerizing one or more monomers" set forth in the claims is related to the process for forming the polymer latex rather than heat developable material. In the absence of providing a step as how to form the heat-developable material, the process as claimed is indefinite.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 13, 5-6, 18-19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP0911691 (EP'691).

EP'691 discloses a process for forming a photothermographic material containing polymer latex which has been treated with a separation fractional polymer or has an ionic conductivity of up to 2,5 mS/cm. Note to the material on page 29 , claims 1-12. Since the polymer latex has been treated before the use thereof in the heat developable material, the material that would affect the property of the photothermographic material would be reduced. Note for instance on page 3 last paragraph, it is disclosed that "a polymer latex is treated with a separation functional polymer as by ultrafiltration is usually carried out plural time", and "is reduced ionic conductivity". Therefore, it asserted that the polymer latex taught in the EP'691 is more purified and the ionic group such as halogen ion would be reduced to very small amount included the halogen ion presented in the claimed invention, and the invention as claimed would be either anticipated or found obvious over EP'691 in the absence of showing otherwise.

6. Claims 7-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP0911691 (EP'691) as applied to claims 1-6 above, and further in view of Kato ('663), Harring et al ('449) and EP0803764 (EP'764).

Kato discloses a compound having a phosphoryl group in its molecule and the amine derivative as high contrast accelerator (abstract, and column 11, lines 17-20); Harring in column 16, lines 51-68, and columns 17-18 disclosed hydrogen donor as contrast enhancing compound; Milton in column 2 discloses a phosphoryl compound as antifoggant for silver halide material; EP'764 on page 12 a phenolic reducing agent of formula (I) of claim 9, including the compound having a

phosphoryl group its molecule as reducing agent. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use a known reducing agent and the high contrast enhancer taught in Kao, Harring, Milton and EP'764 in the material of EP'691 with an expectation of achieving a material producing low fog, stable during storage and high image contrast.

Response to Arguments

7. Applicant's arguments filed March 15, 2004 have been fully considered but they are not persuasive for the reason set forth in the rejections set forth in the paragraph above, and the response to the argument in the final office action on July 14, 2003. The limitation such as "the polymer latex is not subjected to purification through desalting step" fails to further differentiate the process for preparing the heat developable material taught in the applied prior art of record and the process claimed in the present claimed invention. The process for preparing the polymer latex is an intermediate process to prepare the final claimed process that is the process for forming a heat developable material. Even though the invention claimed invention exclude purification thorough desalting step, the polymer latex claimed in the claimed invention and that taught in the applied prior art of record are purified, and would have expected to have less impurity including halide ion. See the specification disclosure on page 26, first paragraph which discloses " the polymer latex for use in the present invention is characterized by having the low halogen ion content. The reduction of halogen content can be conducted by purification of the polymer latex per se through a desalting step using, for example, an ion exchange resin or dialysis membrane". Therefore, the reduction of halogen content can be obtained by desalting

process, and therefore, there is no difference in the composition of the heat-developable material prepared in the applied prior art of record, and that of the present claimed invention.

The argument with respect to the results presented in Tables 2 and 3 of the present specification and reproduced on page 13 of the applicants'argument is not persuasive since the this results are related to the halogen content (ppm) rather than the process for forming the polymer latex not subjecting to purification through desalting steps. The results fails to show that latex prepared by the method of the applied prior art of record even though containing same halogen content do show a good results as compared to that process used in the present claimed invention.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571)272-1328. The examiner can normally be reached on M-F (9:00 - 5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark F. Huff can be reached on (571)272-1385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tchea
May 12, 2004

Thorl Chea
Primary Examiner
Art Unit 1752